

### **REMARKS**

Applicant appreciates the Examiner's thorough consideration provided with respect to the present application. Specifically, Applicant appreciates the courtesies extended by the Examiner during the interview of September 15, 2004. During the interview of September 15, 2004, the Examiner and Applicant's representative discussed the amendment to claim 1 being filed concurrently herewith. The Examiner indicated that he will contact Applicant's representative upon entry and consideration of the enclosed Amendment to discuss the present application in greater detail prior to issuing subsequent communication or Office Action.

Claims 1-4, 8, 11-13, 16-18 and 23 are currently pending in the instant application. Claims 1 and 23 are independent. Claim 1 has been amended and claim 24 has been cancelled. Reconsideration of the present application is earnestly solicited.

### **Reasons for Entry of Amendment**

As discussed in greater detail hereinafter, Applicant respectfully submits that the rejections under 35 U.S.C. § 103(a) are improper and should be

withdrawn. Accordingly, the finality of the Final Office Action mailed on June 16, 2004 should be withdrawn.

If the Examiner persists in maintaining these rejections, Applicant submits that this Amendment was not presented at an earlier date in view of the fact that Applicant is responding to grounds of rejection based upon the Examiner's apparent use of Official Notice (and Applicant's subsequent traversal) in a Final Office Action. Moreover, Applicant is effectively rewriting claim 24 in independent form and thus should not raise any new issues. In accordance with the requirements of 37 CFR 1.116, Applicant respectfully requests entry and consideration of the foregoing amendments as they remove issues for appeal (claims are cancelled) and place the current application in a condition for allowance.

### **Claim Rejections Under 35 U.S.C. § 103**

Claims 1, 3, 8, 11, 13, 16 and 18 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo et al. (U.S. Patent No. 5,828,461) in view of Nielsen et al. (U.S. Patent No. 5,845,122). Claims 2, 4, 12 and 17 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo in view of Nielsen et al., and further in view of Nealon (U.S. Patent No. 5,023,635).

Claim 23 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kubo et al. in view of Nielsen et al. (U.S. Patent No. 5,845,122), and further in view of Hayes (U.S. Patent No. 6,006,279). These rejections are respectfully traversed.

Applicant submits that the prior art of record fails to teach or suggest each and every element of the unique combination of elements of the claimed invention. Further, Applicant submits that the alleged combination(s) of the prior art of record would not have been obvious to one of ordinary skill in the art. Accordingly, these rejections should be withdrawn.

The Examiner has repeatedly relied upon examples of allegedly mutually exclusive special image processes from the prior art of record as practical examples of separate imaging processes that may be combined to read on the claimed invention. However, Applicant respectfully submits that this interpretation is unreasonably broad in light of the amendments to claim 1.

With respect to claim 1, the prior art of record fails to teach or suggest the combination of elements of the claimed invention, including the limitation(s) of "means for carrying out a special image processing on the image data read by the image reading device, the special image processing being specially designated by an operator request; and means for instructing the

special image processing to be carried out by said special image processing means, wherein the special image processing is canceled if *at least two separate special image processes are instructed by said means for instructing and said at least two separate special image processes are combined in a combination other than a predetermined combination of at least two separate special image processes that have been linked together in advance as suitable combinations of separate special image processes*, and the special image processing is not canceled if *at least two separate special image processes are instructed by said means for instructing and said at least two separate special image processes are combined, wherein the predetermined combination is a combination of at least two separate special image processes set in advance, wherein the predetermined combination is a combination of at least two separate special image processes set in advance and at least one of said separate special image processes is selected from the group consisting of LF Lens Correction, Hypersharpness, Hypertone, Facial Expression Improvement, RP Finish, Monotone Finish, Brightness Enhancement, Fine Finish, Portrait Finish, Red Eye Correction and Cross Filter processes.*" (emphasis added)

With respect to claim 23, the prior art of record fails to teach or suggest the combination of elements of the claimed invention, including the

limitation(s) of “means for instructing the special image processing to be carried out by said special image processing means, wherein unsuitable combinations of image processings are prohibited from being executed on the image by said special image processing means and suitable combinations of image processings are permitted to be executed on the image by said special image processing means, *said unsuitable combinations of image processings including a predetermined combination of at least two separate special image processes selected from the group consisting of LF Lens Correction, Hypersharpness, Hypertone, Facial Expression Improvement, RP Finish, Monotone Finish, Brightness Enhancement, Fine Finish, Portrait Finish, Red Eye Correction and Cross Filter processes, wherein said predetermined combination includes an erroneous combination of special image processes.*” (emphasis added) Accordingly, this rejection should be withdrawn.

Applicant appreciates the Examiner’s comments clarifying the rejections under 35 U.S.C. § 103, specifically the Examiner’s interpretation of the term *separate special image processes*. Without conceding the propriety of the Examiner’s rejection, but merely to expedite the prosecution of the present application, Applicant has currently amended claim 1 and previously amended claim 23 to specifically state the separate special image processes.

Accordingly, Applicant submits that the Examiner's reliance upon the Kubo reference is improper and/or fails to establish a proper prima facie case of obviousness.

Applicant submits that the Examiner is interpreting processes such as an image's size, color tone and white margin as separate image processes. In contrast, the Examiner is simultaneously equating the selection of two choices within the same type of special image process as special image processes, e.g., the margin cannot be both 2mm and 3mm, so only one margin can logically be designated (figure 11C) as *separate* image processes. However, the selection of either a 2mm or a 3 mm margin does not involve *separate* image processes. They involve types or choices of the same type of special image process.

Another example relied upon by the Examiner is the choice of color tone, e.g., one allegedly cannot select black and white and also color tone in the prior art of record. Even though the references do not discuss this limitation, it is the Examiner's position that this feature is implied by the references, e.g., it would be illogical not to. However, these choices are not *separate* image processes, but involve the selection of various types of the same special image process, e.g., "color tone." As seen in FIG. 10 of Kubo et al. referred to by the Examiner, one of the options under "color tone" is "monochrome." However,

this is a selection underneath the selection of "color tone" shown in FIG. 10 and is not a separate image process from color tone. Therefore, the Examiner's opinion with respect to the Kubo et al. and/or the Nielsen references dealing with mutually exclusive processes is not relevant to the claimed invention.

The Examiner's reliance upon the alleged use of margin type, paper size, color tone and white margin are not separate special image processes as clearly defined by the claimed invention. In light of the foregoing amendments to the claims, Applicant submits that the Examiner has not identified any teaching in any of the references of the prior art of record to show combinations of *separate* special image processes that are specifically selected from the groups claimed in claims 1 and 23. Therefore, the Examiner's opinion on page 4 of the Final Office Action is improper, as it specifically ignores explicit claim language:

Examiner disagrees with this narrow characterization of the claimed "separate special image processes." Given the broadest reasonable interpretation, "separate special image processes" simply denotes (at least) two different special image processes (i.e. processes that produce different results or are effected by different methods). For example, in figure 11B of Kubo, the user is given a choice of "color" finishing versus "black and white" finishing. It is clear that "color" and "black and white" finishing versus "black and white" finishing. It is clear that "color" and "black and white" finishing are not only separate special image processes, but they are mutually exclusive special image processes as discussed above.

Applicant submits that the Examiner's alleged "broadest reasonable interpretation" of the term separate special image processes would be relevant to a proper prima facie case of obviousness if the term separate special image process were not defined in the claimed invention. However, the term "separate" special image process is explicitly defined in both claims 1 and 23 and specifically states what is meant by a separate special image process. Therefore, based upon the explicit claim language of claims 1 and 23, the Examiner's reference to two types of margin (2mm versus 3mm) and the two types of color tone (monochrome or color, see FIG. 10 of Kubo) as alleged separate special image processes is improper as these alleged separate processes are not separate processes as specifically defined in claims 1 and 23. Accordingly, these rejections should be withdrawn and the present application should be permitted to Issue.

With respect to Nielsen, Applicant submits that one of ordinary skill in the art would not modify the "pull-down" menus of Kubo with the "radio buttons" of Nielsen as alleged by the Examiner. If one were to modify Kubo to include "radio buttons," the resulting combination would not include the "pull-down" menus specifically described by Kubo and therefore would alter the originally intended scope of Kubo.



Further, Kubo et al., Nielsen, or Hayes do not involve any unsuitable combinations of separate special image processes. For example, the Examiner's example of image's size, color tone and white margin involves three separate processes. None of the prior art references involve any suggestion that these three processes involve any limitations on their selection once one of the processes have been selected, i.e., any image size, any color tone and any white margin may be selected. None of the references limit the choices of one special image process after another one has been connected. Therefore, this rejection is improper and should be withdrawn.

In the claimed invention, it is possible to combine special image processings together, e.g, the operator can set any suitable combination to be processed. However, the operator may also set any predetermined combination of processes as being incompatible for each user and may even combine three or more processes that may be processed with the claimed invention, e.g., as described on pages 23 to page 24 (line 9) of the present application.

For example, it is possible to combine processes such as "Hypersharpness" with "Hypertone" and "Hypersharpness" with "Portrait Finish" in the claimed invention. Therefore, the combination of Hypersharpness with Hypertone and/or Hypertone with Portrait Finish may be

selected and processed by a user. Alternatively, Hypersharpness may be cancelled when the combination of Hypersharpness with Portrait Finish is erroneously selected by a user. Applicant submits that the subject matter of claims 1 and 23 is further described in the specification, including the special imaging processes generally described at pages 20 (Table 1), page 29 (lines 3-9), page 30 (lines 5-27) and page 31 (lines 1-21) of the present application; and the necessary image processes described on page 18. None of the prior art references teach or suggest this advantageous feature of the claimed invention.

However, the prior art of record fails to teach or suggest the ability to select combinations of *suitable and unsuitable* special image processes. The Examiner admits that Kubo et al. does not disclose instructing means for prohibiting unsuitable combinations of separate image processes. In order to overcome this shortcoming, the Examiner has suggested that Nielsen et al. teach or suggest this feature. The Examiner has indicated that Nielsen et al. describe a radio button in FIG. 6 of the reference. However, the radio button may NOT be used for the execution of more than one option. Instead, the Examiner asserts that it would be obvious for one of ordinary skill in the art to modify both the Kubo et al. and the Nielsen et al. references to achieve the claimed invention.

For example, the Examiner points to FIG. 4 of Nielsen to show that the prior art of record teaches permissible and impermissible "combinations" of special image processes. The Examiner indicates that a user may make a single selection among "Title," "Book" and "Creation Date," e.g., since these options are mutually exclusive; and a single selection among the group of "Print only to File," and "Printer," since these options are mutually exclusive. However, Nielsen indicates that the single selection among "Title," "Book" and "Creation Date" will NOT have any effect on the selection between "Print only to File" and "Printer." (see col. 5, lines 54-60 of Nielson) Accordingly, two or more special image processes are not interrelated to permit or cancel permissible or impermissible combinations, respectively, of processes as with the claimed invention.

As discussed previously, Kubo and/or Nielsen do not teach or suggest any example that would permit the combination of "Title" and "Book" but reject the combination of "Title" and "Creation Date." In addition, the acceptable combination of "Print only to File" after the selection of "Title" has been made has not been taught or suggested. Alternatively, the selection of "Title" has not been taught as being unacceptable after the selection "Printer" has been made. Finally, Kubo does not disclose any example similar to the claimed invention,

e.g., where "2mm and 3 mm" margins is acceptable, but rejects "2mm and 4mm" margin combinations.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicant respectfully submits that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application. The Examiner is requested to contact the undersigned via telephone in the Washington, DC area to conduct the requested personal interview if this rejection is maintained in any form upon entry and consideration of this Amendment.

Accordingly, reconsideration and withdrawal of the claim rejections is respectfully requested. As to the dependent claims, Applicant respectfully submits that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

### **CONCLUSION**

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but merely to show the state-of- the-art, no further comments are deemed necessary with respect thereto.

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently pending rejections and that they be withdrawn.


It is believed that a full and complete response has been made to the Office Action, and that as such, the Examiner is respectfully requested to send the application to Issue.

In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew T. Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 

Marc S. Weiner  
Reg. No. 32,181

  
MSW/MTS/cl

P. O. Box 747  
Falls Church, VA 22040-0747  
(703) 205-8000